

**REMARKS**

Claims 1-41 were pending. No amendments of the claims have been made. Accordingly, claims 1-41 remain pending.

Applicant thanks the Examiner for withdrawing the objections to the specification, the abstract and the declaration.

**Priority Claim**

The Examiner acknowledged the claim for foreign priority based on Great Britain application GB 9814536.0, but indicated that a certified copy was not filed as required by statute and that Applicant made the priority claim after the required time period had elapsed. The Examiner is incorrect on both counts.

First, in a divisional application of a parent application, in which a certified copy of the priority document was filed in the parent application, there is no requirement that another certified copy be filed. MPEP 201.14(b)(II) states: "Where the benefit of a foreign filing date based on a foreign application is claimed in a later filed application (i.e., continuation, continuation-in-part, division) ... and a certified copy of the foreign application as filed, has been filed in a parent or related application, it is not necessary to file an additional certified copy in the later application. ... The applicant when making such claim for priority may simply identify the application containing the certified copy."

Certified copies of two foreign priority documents were filed in the parent application, US 09/347,311, on March 8, 2001 (received by the USPTO on March 12, 2001 according to the Image File Wrapper).

Second, the Examiner is incorrect in stating that Applicant was tardy in making the claim for foreign priority. Applicant made the claim for foreign priority at the time that the instant application was filed by submitting a copy of the declaration filed in the parent application and indicating that the instant application is a divisional of that parent application. Nothing more should be required. In addition, the USPTO recognized Applicant's claim to foreign priority as reflected on the official Filing Receipt, which lists both GB priority applications.

Considering the foregoing, which Applicant believes to be sufficient proof of timely filing of both a claim for foreign priority and certified copies of the foreign priority documents, Applicant will not file a petition for an unintentionally delayed priority claim, as suggested by

the Examiner. Instead, Applicant respectfully requests that the Examiner withdraw the objections to the filing of certified copies and the priority claim.

### **Rejections Under 35 U.S.C. § 102**

The Examiner has maintained the rejection of claims 1-41 under 35 U.S.C. § 102(a) as being anticipated by Timmons et al. (Nature 395:854, October 1998). Applicant respectfully traverses the rejection.

As noted in the last amendment, the Timmons reference was published in October 1998, which is after Applicant's earliest priority application disclosing the claimed invention, GB 9814536.0 (filed on July 3, 1998). As demonstrated above, Applicant has properly claimed priority to this priority document. Accordingly, the Timmons et al. reference is not prior art to the pending claims and Applicant respectfully requests that the Examiner reconsider and withdraw the rejection made under 35 U.S.C. § 102(a).

The Examiner rejected claims 1-41 under 35 U.S.C. 102(e) as anticipated by the Fire patent (US 6,506,559 B1). The Examiner suggested that Applicant did not address the rejection made over the Fire patent in the previous Office Action. Applicant respectfully traverses the rejection, and notes that no rejection over the Fire patent was made in the previous Office Action. The Examiner may have been thinking of the parent application (US 09/347,311) of the instant application, in which an Office Action did contain a rejection over the Fire patent. Accordingly, Applicant therefore is treating this rejection over Fire as a new rejection.

Applicant traverses the rejection. The Fire patent is not an effective prior art reference against the present claims, because the Fire provisional application serving as a priority document for the Fire patent does not disclose feeding to *C. elegans* a micro-organism expressing dsRNA or containing DNA that encodes and is capable of producing dsRNA.

The Fire patent claims the benefit of US provisional application 60/068,562, filed Dec. 23, 1997. This application, however, does not properly support the subject matter relied upon to make the rejection as required by 35 U.S.C. 112, first paragraph. MPEP 2136.03(III). The portions of the Fire patent pertaining to feeding organisms food containing double stranded RNA are not contained in the Fire provisional application. Accordingly, the Examiner is not entitled to rely on the filing date of the Fire provisional application as the Fire patent's earliest effective filing date.

The filing date of the Fire patent was December 18, 1998. This is the earliest effective filing date for the subject matter relied upon for the rejection of the claims. As already established, Applicant's priority date is July 3, 1998. Applicant's second priority document, filed December 9, 1998, also predates the Fire patent's filing date.

Based on the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection made under 35 U.S.C. 102(e).

### **Finality of the Office Action**

Applicant respectfully requests that the Examiner withdraw the finality of the Office Action. As described above, the current Office Action is the first to reject claims based on the Fire patent (US 6,506,559 B1). Therefore, the finality of the Office action is improper.

### **CONCLUSION**

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,  
*Plaetinck, et al, Applicant*

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